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Atty. Docket No. OPP-GZ-2007-0077-US-00

APR 25 2007

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Geon-Ook PARK

: GROUP ART UNIT: 2818

APPLICATION NO: 10/746,089

:

FILED: December 26, 2003

: EXAMINER: Vu, David

FOR: SEMICONDUCTOR DEVICES AND METHODS TO FORM TRENCHES IN
SEMICONDUCTOR DEVICES

I hereby certify that this document is being facsimile transmitted to the USPTO or deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 25, 2007.

By: 
Jennie Heaton

PETITION UNDER 37 C.F.R. 1.116 AND 1.182

ATTENTION: OFFICE OF PETITIONS
MAIL STOP PETITION
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SIR:

Applicant respectfully petitions the Commissioner for Patents for entry of the Amendment after Final Rejection filed March 26, 2007. The petition fee of \$130.00 under 37 C.F.R. 1.17(h) is authorized to be paid by credit card, a Credit Card Payment Form being submitted herewith.

The facts are as follows:

1. On January 25, 2007, a Final Office Action was mailed from the USPTO in the above application. The Final Office Action included a rejection of Claims 1, 4-6, 14, and 18-26

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under 35 U.S.C. § 103(a) as being unpatentable over Nag et al. (US 6,313,010; hereinafter "Nag") in view of Kim et al. (US 6,001,696; hereinafter "Kim") and further in view of Suzuki et al. (US 6,509,564; hereinafter "Suzuki") and a rejection of Claims 2, 7, 8, and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Nag in view of Kim, further in view of Suzuki, and further in view of Zheng et al. (US 6,342,428; hereinafter, "Zheng"). No further grounds of rejection or objection were included in the Final Office Action.

2. On March 26, 2007, in response to the Final Office Action, an Amendment after Final Rejection was filed. In the Amendment filed March 26, 2007, Claim 1 was amended to include the limitations of Claim 7, and Claim 14 was amended to include the limitations of Claim 16. Claims 7 and 16 were canceled. No new claims were added.

3. 37 C.F.R. 1.116(b) states:

(b) After a final rejection or other final action (§ 1.113) in an application... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

4. The Amendment filed March 26, 2007 clearly canceled Claims 7 and 16 without adding any new claims, thereby complying with 37 C.F.R. 1.116(b)(1). Looking at the Amendment filed March 26, 2007 a different way, Claims 1 and 14 represent Claims 7 and 16 rewritten in independent form. Effectively, Claims 1 and 14 were canceled and replaced with Claims 7 and 16 in independent form.

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5. The Amendment filed March 26, 2007 clearly presents the rejected claims in better form for consideration on appeal, thereby complying with 37 C.F.R. 1.116(b)(2). The Final Office Action contains two grounds of rejection. Claims 1 and 14 (among other claims) were rejected in view of Nag, Kim and Suzuki. Claims 7 and 16 (among other claims) were rejected separately in view of Nag, Kim, Suzuki, and Zheng. The amendment to combine Claim 1 with Claim 7 and Claim 14 with Claim 16 obviates the rejection of Claims 1 and 14 (among other claims) in view of Nag, Kim and Suzuki. Thus, Amendment filed March 26, 2007 reduces the number of issues for appeal, thereby presenting the rejected claims in better form for consideration on appeal.

6. On April 12, 2007, the USPTO mailed an Advisory Action refusing to enter the Amendment filed March 26, 2007 because, in the Examiner's opinion, it "raise[s] new issues that would require further consideration and/or search."

7. The Manual of Patent Examining Procedure (MPEP) teaches examiners to consider amendments after final and enter them in certain limited cases, as is explained below (with reference to the MPEP).

8. Any amendment timely filed after a final rejection *should be immediately considered to determine whether it places the application* in condition for allowance or *in better form for appeal*. MPEP 714.13, section III, entitled "Action by Examiner" (emphasis added). Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal, if a separate paper were filed containing only such amendments. MPEP 714.13, section III.

9. In the event that a proposed amendment does not place the case in better form for appeal (or in condition for allowance), applicant should be promptly informed of this fact. MPEP 714.13, section III. The refusal to enter the proposed amendment *should not be arbitrary*. MPEP 714.13, section III (emphasis added). The proposed amendment *should be given sufficient consideration to determine whether the issues on appeal are simplified*. MPEP 714.13, section III (emphasis added).

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10. Of course, applicants cannot, as a matter of right, amend any finally rejected claims. 37 CFR §§ 1.113 and 1.116, and MPEP 714.13, section II, entitled "Entry not a Matter of Right." Compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection, *except where an amendment* merely cancels claims or *removes issues for appeal*. MPEP 714.13, section II (emphasis added).

11. It does not appear that the Examiner in the present case gave sufficient consideration to the Amendment filed March 26, 2007 to determine whether it places the application in better form for appeal.

12. For example, the Examiner did not inform Applicant that the proposed amendments filed March 26, 2007 do not place the case in better form for appeal or notify Applicant that certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal, if a separate paper were filed containing only such amendments. See the Advisory Action dated April 12, 2007.

13. It thus appears that the Examiner arrived at the conclusion that the Amendment filed March 26, 2007 raises new issues, without determining whether it placed the case in better form for appeal.

14. In addition, the Advisory Action merely asserts that the scope of the dependent claims (i.e., Claims 2, 4-6, 8, 14, 15 and 17-26) has changed, "thus requiring further consideration." Page 2, lines 3-7 of the Advisory Action.

15. As mentioned above, Claims 2, 7, 8, and 15-17 were rejected in view of Nag, Kim, Suzuki, and Zheng. If Nag, Kim, Suzuki, and Zheng disclose or suggest each of the limitations of Claims 2, 7, 8, and 15-17 and provide motivation to one of ordinary skill in the art to combine those elements in the manner necessary to arrive at the present invention, then it is not clear why a combination of the limitation of two of these Claims would necessitate a further search or anything more than cursory consideration. A cursory reading of the Final Office Action shows that the Examiner considered the claim limitations of each of Claims 2, 7, 8, and 15-17 and explained how the cited references apply to those claim limitations (see pp. 4-5 of the

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Office Action mailed January 25, 2007; note that Applicant's undersigned representative does not agree with such application of the references, but that is not an issue for this Petition). Given the possibility, however, that such a combination of claim limitations could require further consideration, the burden is on the Examiner to explain why:

"If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search." MPEP 714.13, section II.

16. Merely asserting that the claim scope has changed would appear to be insufficient explanation under the guidelines of MPEP 714.13 when all of the limitations in the proposed amendment had been considered and had been rejected in view of the same references.

17. Similarly, Claims 1, 4-6, 14, and 18-26 were rejected in view of Nag, Kim and Suzuki in the Final Office Action. Each of the Nag, Kim and Suzuki references were also used to support the rejection of Claims 7 and 16 (see the preceding paragraph). For reasons similar to those explained in the preceding paragraph, it is not clear why a combination of the limitations of Claim 7 with one of Claims 4-6 (or a similar combination of the limitations of Claim 16 with one of Claims 18-26) would necessitate a further search or anything more than cursory consideration. Alternatively, if such a combination of claim limitations actually requires further consideration, the Examiner has not met the burden of providing reasons why the proposed amendment raises new issues that would require further consideration and/or search.

18. Further, Petitioner sayeth not.

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Accordingly, Applicant (through the undersigned representative) respectfully requests entry of the Amendment filed March 26, 2007. Additional information and/or assistance with this Petition may be obtained from the undersigned practitioner.

Respectfully submitted,



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